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# CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

*Submit an original, and a duplicate for fee processing.  
(Only for Continuation or Divisional applications under 37 CFR 1.53(d))*

CHECK BOX, if applicable:  
 DUPLICATE

Address to:  
Assistant Commissioner for Patents

Box CPA  
Washington, DC 20231

Attorney Docket No.  
of Prior Application

First Named Inventor	Hans Seiter
Examiner Name	T. Arnold, III
Group Art Unit	3728
Express Mail Label No.	

This is a request for a  continuation or  divisional application under 37 CFR 1.53(d),  
(continued prosecution application (CPA)) of prior application number 09 / 423,619,  
filed on 11/15/99, entitled INNER SOLE FOR A SHOE

## NOTES

**FILING QUALIFICATIONS:** The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

**C-I-P NOT PERMITTED:** A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

**EXPRESS ABANDONMENT OF PRIOR APPLICATION:** The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

**ACCESS TO PRIOR APPLICATION:** The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

**35 U.S.C. 120 STATEMENT:** In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

1.  Enter the unentered amendment previously filed on \_\_\_\_\_ under 37 CFR 1.116 in the prior nonprovisional application.
2.  ~~A Preliminary Amendment is enclosed.~~ A Preliminary Response is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
  - a.  **DELETE** the following inventor(s) named in the prior nonprovisional application:  
.....
  - b.  The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4.  A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
  - a.  PTO-1449
  - b.  Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR 1.16(c) or (i))	5 -20* =		x \$ _____ =	\$
	INDEPENDENT CLAIMS (37 CFR 1.16(b) or (i))	1 -3** =		x \$ _____ =	
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			+ \$ _____ =	
				BASIC FEE (37 CFR 1.16)	\$ 710.00
			Total of above Calculations =		\$ 710.00
	Reduction by 50% for filing by small entity (Note 37 CFR 1.27).				\$ 355.00
	* Reissue claims in excess of 20 and over original patent. ** Reissue Independent claims over original patent.			TOTAL =	\$ 355.00

6.  Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 10 - 1213:
  - a.  Fees required under 37 CFR 1.16.
  - b.  Fees required under 37 CFR 1.17.
  - c.  Fees required under 37 CFR 1.18.
8.  A check in the amount of \$ 355.00 is enclosed.
9.  Payment by credit card. Form PTO-2038 is attached.
10.  Applicant requests suspension of action under 37 CFR 1.103(b) for a period of \_\_\_\_\_ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11.  New Attorney Docket Number, if desired  
*[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]*
12. a.  Receipt For Facsimile Transmitted CPA (PTO/SB/29A)
  - b.  Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13.  Other: Request for Extension of Time

**NOTE:** *The prior application's correspondence address will carry over to this CPA  
UNLESS a new correspondence address is provided below.*

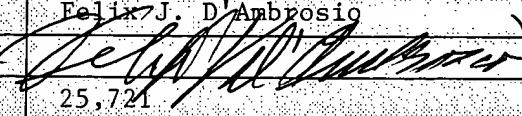
#### 14. NEW CORRESPONDENCE ADDRESS

Customer Number or Bar Code Label  New correspondence address below

*(Insert Customer No. or Attach bar code label here)*

Name			
Address			
City	State		Zip Code
Country	Telephone		Fax

#### 15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Felix J. D'Ambrosio
Signature	
Registration No. (Attorney/Agent)	25,721
Date	July 25, 2001



8/1/01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re CPA of )  
Hans Seiter ) Art Unit: 3728  
Appn. No. : 09/423,619 ) Ex: T. Arnold, III  
Filed : July 25, 2001 )  
For : INNER SOLE FOR A SHOE )

16#  
sk.  
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*[Handwritten signatures and initials over the stamp]*

**PRELIMINARY RESPONSE**

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Prior to an examination on this CPA of Application No. 09/423,619 the following remarks regarding the Advisory Action of July 3, 2001 are being submitted.

**REMARKS**

**The Advisory Action**

On page 2 of the Advisory Action, the examiner states "...that Pendergast does teach the cushioned layers claimed in claim 26.....Regardless of the perceived benefits of the instant invention, or its intended uses, or what certain features were 'designed to accomplish' by the inventor, it is maintained that Pendergast.....teaches the specific structural limitations claimed."

**Reply**

The "perceived benefits" of the structure defined in the claims is not the only reason that these claims define over Pendergast, it is also structure. Claims 26 define cushioned layers. The examiner states that Pendergast "teach the cushioned layers." Applicant cannot